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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,795	12/02/2003	Thomas G. Cooper	017516-009610US	6144
7590 03/07/2006			EXAMINER	
FRANK NGUYEN INTUITIVE SURGICAL, INC. 950 KIFER ROAD SUNNYVALE, CA 94086			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,795

Applicant(s)

COOPER ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 43-46 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 12, 13 and 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 43-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The request filed on 2/14/2006 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/726,795 is acceptable and a RCE has been established. An action on the RCE follows.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 43, the disclosure corresponding to elected Species 1 in figures 1-3 on 8/25/2004 describes an **inner spring** and a **wire wrap** which both points to the same element such as item 34. Clarification is requested.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Morley et al (6,676,684).

Morley et al disclose in figures 6-8, abstract, a device for providing a minimally invasive surgical tool having the limitations as recited in claims 1-3, including: an elongate shaft (14.1,14.3), an end effector (58), a wrist member (52) has a flexible tube which is connected to the working end of the elongate shaft and a distal portion connected to the end effector and a spring (70, see col. 9, lines 40-52), where the spring is disposed inside the cavity of the tube, and where a plurality of cables (C1,C2) can dispose inside the inner spring and capable of connecting to the end effector which are capable of bending the wrist member in pitch (fig. 7) rotation and yaw (fig. 6) rotation.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Madhani et al (6,786,896).

Madhani et al disclose in figures 1-3, a device for providing a minimally invasive surgical tool having the limitations as recited in claims 1-3, including: an elongate shaft (312), an end effector (318), a wrist member (316) has a flexible tube and a spring (see col.24, lines 10-35), where the spring is disposed inside the cavity of the tube, and where a plurality of cables (see col. 16, lines 59-67 and col. 17, lines 1-24) connected to the end effector which are capable of bending the wrist member in pitch (fig.2) rotation and yaw (at joint 6, see col. 15, lines 49-67) rotation.

***Response to Arguments***

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4. Applicant's arguments filed 11/2/2005 have been considered but they are not persuasive.

In response to applicant's argument that Morley reference does not disclose a wrist member having a flexible tube and an inner spring: The examiner, respectfully, disagrees. As claim 1 is currently written, it can be interpreted broadly that the Morley reference at least discloses in figures 6-7, a wrist member (52) having a flexible tube and an inner spring (70). There is some degree of flexibility in all materials. Therefore, the wrist member 52 can have a flexible tube that is bendable (fig. 8) in order to change the orientation of the end effector (58) as a whole, relative to the wrist member. Accordingly, the above noted reference is still considered to read on the claimed limitations of the claimed noted.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn VN  
3/2/2006



JULIAN W. WOO  
PRIMARY EXAMINER